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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/581,306
	Filing Date	07/07/2000
	First Named Inventor	Wilson Zehr
	Art Unit	2157
	Examiner Name	Salad, Abdullahil Elmi
Total Number of Pages in This Submission	Attorney Docket Number	111219-135015

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
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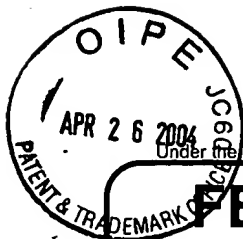
Technology Center 2100

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 165.00

## Complete if Known

Application Number 09/581,306  
Filing Date 07/07/2000  
First Named Inventor Wilson Zehr  
Examiner Name Salad, Abdullahi Elmi  
Art Unit 2157  
Attorney Docket No. 111219-135015

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APR 29 2004

Technology Center 2100

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number  
Deposit Account Name

500393

Schwabe, Williamson et al

The Director is authorized to: (check all that apply)

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## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ ) 0.00

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X	<input type="text"/>	<input type="text"/>
Multiple Dependent					<input type="text"/>	<input type="text"/>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0.00

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	165
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 165.00

## SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Aloysius T.C. AuYeung  
Registration No. (Attorney/Agent) 35,432  
Telephone 503-222-9981  
Signature [Signature]  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#17  
RMB  
5-4-04

In re Application for:

**Zehr et al**

Application No.: 09/581,306

Filed: July 7, 2000

Priority: March 19, 1999

For: Distributed System For Conducting  
Physical Delivery Mail Service  
Over The Internet

Examiner: Salad, Abdullahi Elmi

Art Group: 2157

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**Appellant's Brief Under 37 C.F.R. §1.192 In Support Of  
Appellant's Appeal To The Board Of Patent Appeals And Interferences**

Dear Sir:

The Appellant hereby submits this Brief in support of their appeal from a final decision by the Examiner, mailed December 3, 2003, in the above referenced case.

The final decision was in response to arguments filed on May 21, 2003, in response to an earlier final office action, mailed March 27, 2003. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for

allowance of the present patent application.

04/28/2004 MAHNE1 00000036 09581306

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### **(1) Real Party In Interest**

The real party in interest is Launchpoint, Inc, a corporation having its primary place of business at 2800 NW 29<sup>th</sup> Ave., Portland, OR 97210-1704.

### **(2) Related Appeals And Interferences**

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal, which will directly affect, be directly affected by, or have a bearing on the Board's decision.

### **(3) Status Of The Claims**

Claims 1-6 and 8-15 remain pending and are reproduced, as pending, in Appendix A.

Claims 1, 5 and 11 were rejected under 35 USC §102(b) as being anticipated by Maxwell USP 5,805,810, in the Final Office Action dated December 3, 2003.

Claims 2-4, 6-10 and 12-15 were rejected under 35 USC §103 as being obvious in view of Maxwell in combination with one or more other references.

### **(4) Status of Amendments**

No claim amendments have been made since the mailing date of the final rejection.

### **(5) Summary of the invention**

Embodiments of the present invention include a novel distributing system for distributively facilitating physical mailing utilizing electronic messaging. In one embodiment, the present invention includes a server equipped to receive an electronic message that includes message attributes including a message recipient and printing criteria, determine a recipient physical address responsive to the message recipient attribute contained with the electronic message, compare the message recipient physical address with a plurality of printing locations, select one of the printing locations based at least in part on the results of said compare and send the electronic message to the selected printing location.

### **(6) Issues Presented**

- I. Whether claims 1, 5, 11 are patentable under 35 U.S.C. §102?
- II. Whether claims 2-4, 6, 8-10, 12-15 are patentable under 35 U.S.C. §103?

### **(7) Grouping of claims**

For purposes of this appeal, based on the above listed grounds of rejection, all claims 1-6 and 8-15 stand or fall together.

## (8) Arguments

Rejection of claims 1, 5 and 11 under 35 U.S.C. §102(a)<sup>1</sup> was improper because Maxwell failed to teach **at least one recited limitation** of each of these claims.

The law is well settled that anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art, **each and every** limitation of a claimed invention. See e.g. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). Thus to anticipate the present invention, *Maxwell* (USP 5,805,810), the prior art relied upon by the Examiner, must disclose and teach each and every element of claims 1-12 and 23-26.

Claim 1 recites

1 A mail delivery apparatus for delivery of mail to a user's physical address comprising:

a storage device; and  
a processor coupled to the storage device;  
the storage device storing a program for controlling the processor; and  
the processor operative with the program to  
receive an electronic message that includes message attributes including  
a message recipient and printing criteria,  
determine a recipient physical address responsive to the message  
recipient attribute contained with the electronic message,  
compare the message recipient physical address with a plurality of printing  
locations,  
select one of the printing locations based at least in part on the results of  
said compare; and  
send the electronic message to the selected printing location.

Accordingly, claim 1, requires an element adapted to  
compare the message recipient physical address with a plurality of printing  
locations,

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<sup>1</sup> In the Final Office Action, the Examiner cited Maxwell as a 102(b) prior art, and later in the Advisory Action corrected it to a 102(e) prior art. Neither are correct. Given Maxwell was issued approximately 9 months before Appellants' priority date, Applicants assume the Examiner meant 102(a).

select one of the printing locations based at least in part on the results of said compare; and  
send the electronic message to the selected printing location  
(hereinafter, the COMPARE, SELECT and SEND operations).

In rejecting claim 1, the Examiner relied on Maxwell (USP 6,154,818). In particular, the Examiner asserted that Maxwell anticipated the required element for performing the enumerated COMPARE, SELECT and SEND operations, relying on Maxwell's disclosure on col. 13, line 33, to col. 14, line 67).

As Applicant explained in an earlier response, starting on col. 13, line 33, running through col. 14, line 16, Maxwell merely disclosed

- a "message validator" accesses the recipient database to determine whether recipients identified in email messages by senders have been previously registered (col. 13, lines 33-37); and

- an implementation of the recipient database (col. 13, lines 38-50).

Starting with col. 14, line 17, and running through line 29, Maxwell asserted certain benefit of its invention, that is, its invention

"permits a sender located in one country (e.g. Brussels) to send a letter (i.e. netgram) to a recipient in another country (e.g. United States), eliminating the need to use international postal services (i.e. the postal service of both countries) and minimizing the postal charges resulting from using international postal services".

The disclosure is assertion of a benefit, not the teaching of an element (including its implementation) to achieve the benefit. Thus, the cited passage, by definition cannot anticipate any element, in particular the required element of claim 1.

The law is also well settled that if there was anticipation, ***there should have been symmetry with infringement***, "That which infringes if later, anticipates if earlier", see e.g. Kalman v Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781 (Fed Cir. 1983), cert denied, 465 U.S. 1026 (1984). In other words, if Maxwell, in particular, the cited passages have taught an element that anticipated the required element in claim 1,

then applicant should be able to find Maxwell, in particular, the cited passage infringing, had Maxwell been later than the application on appeal.

However, no such infringement can be found in the cited passage.

As Appellant has explained in a prior response, the asserted benefit can be achieved by a system located in the U.S., offering networked access to a sender in Brussel, to send a electronic message to the U.S. located server, to cause the desired physical mail to be generated and mailed to a desired recipient in the U.S.

Further, Maxwell's defense would be completely supported by its own description of the operating logic of its Print Queue Processor, which was provided, starting in col. 12, line 37, running through col. 13, line 9. No where in these descriptions can any trace of the required COMPARE, SELECT and SEND operations can be found.

Accordingly, given Maxwell cannot be found as infringing on Applicant's claim, had Maxwell be later than Applicant, there is no symmetry between Maxwell and Applicant's teachings. Without symmetry there could be no anticipation by Maxwell.

The above discussed failure of Maxwell can also be analyzed from the perspective of Maxwell failing to meet the well settled law of an anticipatory prior art having to have **sufficient disclosure to enable** a person of ordinary skilled in the art to practice the invention. See e.g. In re Paulson, 30 F.3d, 1475, 1478, 31 SPQ 2d 1671, 1673 (Fed. Cir. 1994). As discussed earlier, the passage relied by the Examiner merely asserts a benefit, and the detailed description of the Print Queue Processor contains no teachings for a person of ordinary skill on how to accommodate a sender from any location, sending electronic messages to cause physical mails to be delivered to recipients at any location.

Thus, whether analyzed from the "**symmetry**" perspective, or from an "**enablement**" perspective, Maxwell does not anticipate claim 1. Without anticipation by Maxwell, claim 1 is patentable under 102(a).



Claims 5 and 11 contain in substance the same distinguishing limitations of claim 1. Accordingly, for at least the same reasons, claims 5 and 11 are patentable over Maxwell.

Claims 2-4, 6, 8-10, and 12-15 are dependent on either claim 1, 5 or 11, incorporating its limitations. Accordingly, for at least the same reasons, claims 2-4, 6, 8-10, and 12-15 are patentable over Maxwell. None of the additional cited references remedy the above discussed deficiency of Maxwell. Thus, claims 2-4, 6, 8-10, and 12-15 remain patentable over Maxwell, even in view of these additional references.

### **(9) Conclusion**

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

### **(10) Epilogue**

This brief is submitted in triplicate, along with a check for \$165 to cover the filing of appeal brief fee for a small entity as specified in 37 C.F.R. §1.17(c). We do not believe any fees, in particular extension of time fees, are needed. However, should that be necessary, please charge our Deposit Account No. 500393.

In addition, please charge any shortages and credit any overages to Deposit  
Account No. 500393.

Respectfully submitted,  
Schwabe, Williamson & Wyatt, P.C.

Dated: April 23, 2004



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By Aloysius AuYeung, Reg No. 35,432  
Attorney for Appellant Applicant

## Appendix A – Claims As Pending

1 1. (Once Amended) A mail delivery apparatus for delivery of mail to a user's physical  
2 address comprising:

3 a storage device; and

4 a processor coupled to the storage device;

5 the storage device storing a program for controlling the processor; and

6 the processor operative with the program to

7 receive an electronic message that includes message attributes including a  
8 message recipient and printing criteria,

9 determine a recipient physical address responsive to the message recipient  
10 attribute contained with the electronic message,

11 compare the message recipient physical address with a plurality of printing  
12 locations,

13 select one of the printing locations based at least in part on the results of said

14 compare and

15 send the electronic message to the selected printing location.

1 2. (Once Amended) The apparatus of claim 1, in which

2 the processor is further operative with the program to:

3 query the printing locations having a desired set of attributes responsive to

4 the printing criteria contained with the electronic message, and

5 receive replies from the printing locations responsive to the query; and

6 said select of one of the printing locations is further based at least in part on

7 the replies.

1 3. (Once Amended) The apparatus of claim 1, further including a database for  
2 storing a user record, said record having a counter measuring use of the mail  
3 delivery apparatus and operative with a promotional program to effect awarding  
4 prizes to the user.

1 4. (Original) The apparatus of claim 1, the database further including a plurality of  
2 advertisements, advertising attributes and recipient demographics, in which the  
3 processor is further operative with the program to:  
4 compare the advertising attributes to the recipient demographics;  
5 select at least one of the advertisements; and  
6 attached the selected advertisement(s) to the electronic message.

1 5. (Once Amended) A method for converting an electronically generated message to  
2 a physical mail object to be delivered to a mail recipient's physical mail address,  
3 comprising:  
4 accessing an intermediate node from a sender's node on a global communication  
5 network;  
6 after accessing the intermediate node, transmitting information to the  
7 intermediate node including message, message recipient, and printing criteria;  
8 locating in a database the physical address information of the mail recipient;  
9 comparing the physical address information of the mail recipient to locations of a  
10 plurality of printing stations distributed across the global communications network;  
11 generating a printing instruction to print the message for delivery to the mail  
12 recipient at the recipient physical address, for a selected one of the printing stations,  
13 responsive to at least the result of said comparing; and

14        sending the printing instruction to the selected one of the printing stations to  
15        perform said printing for said delivery.

1        6. (Once Amended) The method of claim 5, wherein the method further comprises  
2        querying the plurality of printing stations for printing station information, and storing  
3        the information from each of the printing stations at the intermediate node.

1        7. (Cancelled)

1        8. (Once Amended) The method of claim 6, wherein the printing station information  
2        includes a printing capability of the printing station.

1        9. (Once Amended) The method of claim 6, wherein the printing station information  
2        includes a printing capacity of the printing station.

1        10. (Once Amended) The method of claim 6, further includes:  
2        accepting bids from a plurality of advertisers having associated advertisements;  
3        selecting one or more advertisements based upon the bids; and  
4        inserting the selected one or more advertisements within the printing instruction.

1        11. (Once Amended) A method for using a computer to facilitate communication  
2        between a message sender and at least one intended recipient, comprising:  
3        inputting into the computer a message;  
4        inputting into the computer a recipient physical address corresponding to the  
5        intended recipient of the message;

6        outputting the message and the recipient physical address electronically to a mail  
7        server;  
8        comparing the recipient physical address with a plurality of distributed printing  
9        locations;  
10       distributing the message to a selected one of the plurality of printing locations  
11       responsive to at least the result of said comparing; and  
12       printing the message at the selected one of the plurality of locations for delivery  
13       to the intended recipient.

1       12. (Once Amended) The method of claim 11, wherein the comparing includes  
2       calculating a goodness factor based in part upon a proximity of the plurality of  
3       distributed printing locations to the recipient physical address.

1       13. (Once Amended) The method of claim 11, wherein the method further includes  
2       calculating a goodness factor based in part upon a capacity of the plurality of  
3       distributed printing locations, and the selecting is further based on the goodness  
4       factor.

1       14. (Once Amended) The method of claim 11, wherein the method further includes  
2       calculating a goodness factor based in part upon a capability of the plurality of  
3       distributed printing locations, and the selecting is further based on the goodness  
4       factor.

1       15. (Once Amended) The method of claim 11, wherein the method further includes  
2       calculating a goodness factor based in part upon a price per impression bid by of the

- 3 plurality of distributed printing locations, and the selecting is further based on the
- 4 goodness factor.